

REMARKS

Applicant affirms the provisional election of Group I, claims 1-23, 32 and 33.

The Examiner has objected to the drawings because "they fail to show detail A as described in the specification." In response to this objection, Applicant has corrected the specification, deleting the erroneous reference to detail A. The phrase "detail A" was not referring to a structural feature that was omitted from the drawings, but was merely intended to refer to the area of FIG. 3 that is shown enlarged in FIG. 4. This has been clarified by the amendment to the specification.

The specification has been objected to because the descriptions for Figures 4 and 5 appear on the same line. This error has been corrected herein.

Claim 32 has been objected to on the basis that the C-shaped cross-section claimed is not in the drawings. In order to reduce issues and advance prosecution Applicant has cancelled claims 32 and 33 without prejudice. Applicant reserves the right to re-introduce these claims and address this issue during further prosecution.

Claims 1-3, 5, 7, 8 and 32 have been rejected under 35 U.S.C. 102(b) as being anticipated by Kubica (U.S. 6,349,520). While Applicant does not concede that this rejection is proper, in order to advance prosecution Applicant has amended claim 1 to include the features of claims 3, 11 and 12. Applicant has also amended claim 1 to add an upper limitation on the wall thickness of about 1.0 inch. Support for this limitation is found at page 5, line 24 of Applicant's specification. This rejection is moot in view of the amendment to claim 1.

Claims 11 and 12, which have now been incorporated into claim 1, have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kubica.

The Examiner takes the position that the dimensions claimed by Applicant, i.e., that the wall of the slot have a thickness of at least 0.375" and that the thickness of the insulating member in regions between the slots be from about 1.0 to about 3.5", are merely a matter of obvious optimization. The Examiner contends that the artisan would have optimized these thicknesses "to provide sufficient insulation while conserving insulating material." However, Applicant disagrees that these considerations would have led to the claimed dimensions. Applicant was

faced with a different set of constraints, imposed by the procedures used in wood frame construction. For example, Applicant found that it was important that the wall be sufficiently thick to prevent it from breaking, and yet sufficiently thin so that it could be nailed through to securely attach the insulating member and floor joist to the floor joist header. Between the slots, the insulation needed to be thick enough for adequate thermal performance, but not so thick as to prevent a carpenter from nailing the insulating member and joist header to the wall top plate or foundation sill. The artisan would not have been motivated to modify Kubica's insulating member to have the claimed relative dimensions, *without resort to Applicant's own disclosure*.

Claims 4, 6, 13-19, 22, 23 and 33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kubica in view of L'Heureux (U.S. 4,967,529).

Claims 4 and 6 are patentable for at least the reasons advanced above with regard to claim 1, as L'Heureux adds nothing of relevance regarding the claimed dimensions.

Claim 13, as amended, requires: (a) a single unitary thermal insulating member, including a plurality of slots extending width-wise across the member, each slot being configured to receive an end of a floor joist; and (b) a wood member, configured so that the wood member will function as a joist header in the wood frame construction, mounted on the insulating member. Applicant first notes that "configured to receive an end of a floor joist" and "configured so that the wood member will function as a joist header" are structural limitations, rather than merely statements of intended use. These phrases define the characteristics of the slots and wood member, respectively, using well understood terms of art ("floor joist" and "joint header"). Thus, the slot has structural characteristics (size, shape, structural integrity) that make it capable of receiving an end of a floor joist, and the wood member has structural characteristics that enable it to be used as a joist header.

First, neither reference teaches or suggests slots that are configured to receive an end of a floor joist. There is nothing to suggest that the slots shown in FIG. 9 of Kubica could be so used -- that is certainly not Kubica's intention -- and no slots of any kind are shown in L'Heureux. Nor does either reference teach or suggest a wood member that is configured for use as a joist header. While the Examiner asserts that the board 1 of L'Heureux is a joist header, this is not in

fact the case. Instead, the board 1 is plywood of 3/8" thickness (see col. 4, lines 3-6) - a material that would not have adequate thickness or strength for use as a joist header. Thus, the Examiner has not established *prima facie* obviousness.

Second, it would not have been obvious to one of ordinary skill in the relevant art - wood frame construction - to look to Kubica at all, much less to combine the teachings of L'Heureux with those of Kubica. In order to rely on a reference as a basis for rejection, the reference must be analogous prior art. MPEP 2141.01(a). To be analogous prior art, "a reference must either be in the field of Applicant's endeavor, or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Id., quoting *In re Oeticker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Kubica pertains to casting concrete walls, which is neither in the field of Applicant's endeavor (wood frame construction, which is an entirely separate field from concrete wall construction) nor reasonably pertinent to the problem with which the inventor was concerned (thermally insulating between floor joists in wood frame construction). Thus, Applicant submits that Kubica is not a proper basis for a rejection under 35 U.S.C. 103(a).

Nor would it have been obvious to combine the teachings of L'Heureux with those of Kubica. The Examiner asserts that it would have been obvious to mount the insulating member of Kubica on a joist header, in view of the teachings of L'Heureux, in order "to increase the structural rigidity of the assembly." However, the insulating members of Kubica are supported by rigid wall forms 12 during molding, and by the concrete wall itself after molding, and thus there would be no reason to increase their structural rigidity. Nor would the artisan have expected that the concrete would necessarily bond as well to wood as directly to the insulating member.

Finally, even if the artisan had applied L'Heureux's wood board to Kubica's insulating member, Applicant's claimed invention would not result, as the board 1 described by L'Heureux would not be suitable for use as a joist header for the reasons discussed above.

Claims 9 and 10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kubica in view of Berdan (U.S. 6,042,911), and claims 20 and 21 have been rejected as unpatentable over Kubica in view of L'Heureux and Berdan. Applicant respectfully submits that

Applicant : Joel A. Schwartz  
Serial No. : 10/798,682  
Filed : March 11, 2004  
Page : 11 of 11

Attorney's Docket No.: 10189-002001

these claims are patentable for at least the reason that they depend from a patentable base claim, as discussed above. Berdan does not add anything that would have led the artisan to modify Kubica so as to reach the claimed invention.

In view of the above, Applicant respectfully submits that all claims are in condition for immediate allowance, which is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reason for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to amendment.

Please charge the Petition for Extension of Time fee, and apply any other charges or credits, to deposit account 06-1050, referencing Attorney Docket No. 10189-002001.

Respectfully submitted,

Date: September 24, 2007

/Celia H. Leber/  
Celia H. Leber  
Reg. No. 33,524

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906